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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,927	04/09/2001	Takeo Hara	205746US0	8486

22850 7590 03/25/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

TRINH, MICHAEL MANH

ART UNIT PAPER NUMBER

2822

DATE MAILED: 03/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicant(s)

09/827,927

Applicant(s)

HARA ET AL.

Examiner

Michael Trinh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 30 days ~~MONTH(S)~~ FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) 1-11, 14-17, 27-29, 39-46 and 48-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 12, 13, 18-26, 30-38, 47, 56 and 57 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**Part III DETAILED ACTION**

\*\*\* This office action is in response to Applicant's response filed on December 31, 2002.

***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:
  - I. Claim 12, drawn to a first process for producing a composite sheet.
  - II. Claim 13, drawn to a second process of using a composite sheet.
  - III. Claims 18-26, drawn to a third process of producing a composite sheet.
  - IV. Claims 30-38, drawn to a fourth process for producing a composite sheet.
  - V. Claim 47, drawn to a fifth process of producing a composite sheet.
  - VI. Claims 56-57, drawn to a sixth process for using a composite sheet.

Currently, there is no generic claim. Group I invention to Group VI invention are species and distinct, each from the other, combination and subcombination, because the method of Group I invention differently draws to a first process for producing a composite sheet so as to obtain a semi-cured composite sheet by curing the photocuring component of the sheeted composition comprising a photocuring component and a thermosetting component; while Group II invention differently draws to a second process of using a composite sheet by interposing a semi-cured composite sheet and curing the thermosetting component to form a cured composite sheet; while Group III, differently drawn to a third process of producing a composite sheet by interposing a sheeted composition between a pair of magnetic pole plates, and not applying a magnetic field to bundled the magnetic fibrous fillers but also curing the binder; while Group IV, differently drawn to a fourth process for producing a composite sheet by bringing at least one side of a sheeted composition in contact with a surfaces of nonmagnetic substance having a plurality of concaves, and not applying a magnetic field to bundled the magnetic fibrous fillers but also curing the binder; while Group V, differently drawn to a fifth process of producing a composite sheet by sheeting a composition comprising a thermosetting and/or photocuring binder, and organic fin particles or inorganic fine particles and not only applying magnetic field to orientate the magnetic fibrous filler but also curing the binder; and while Group VI differently drawn to a sixth process for using a composite sheet by electrically connecting an electrode of a semiconductor element and an electrode of a circuit substrate to each other through a composite sheet comprising at least 80% of magnetic fibrous filler having both conductivity and magnetism and having a fiber length satisfying the relationship  $0.5xD < L1, (L_2^2 + D^2)^{1/2}$ .

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Because these inventions are species and distinct, combination and subcombination, for the reasons given above and have acquired a separate status, the fields of search are not co-extensive and separate examination would be required, restriction for examination purposes as indicated is proper.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Trinh whose telephone number is (703) 308-2554. The examiner can normally be reached on Monday through Friday, from 9:00 Am to 5:00 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amir Zarabian, can be reached on (703) 308-4905. The fax phone number for this Group is (703) 305-3432 or (703) 308-7382.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

-Oasc-



Michael Trinh  
Primary Examiner